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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,668	10/11/2001	Seiichi Hirano	448563/0046	2079
7590 04/06/2004				
Lawrence Rosenthal Stroock & Stroock & Lavan LLP 180 Maiden Lane New York, NY 10038			EXAMINER BROOKE, MICHAEL S	
			ART UNIT 2853	PAPER NUMBER
DATE MAILED: 04/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,668

Applicant(s)

HIRANO ET AL.

Examiner

Michael S. Brooke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 24-38 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/834,151.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Reissue Applications

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii (JP-04007185) in view of Saito et al. (5,136,308).

Ishii teaches an ink jet print head (12) having a nose portion through which ink is ejected. The printer comprises a paper feeding path, a paper feed roller (1) having a peripheral surface coincident with a portion of the feed path, a presser (4), which is a pinch roller, that abuts the feed roller at a contact position, a flat paper guide (5) that is disposed downstream of the contact position and a deflector (17) that is located downstream and apart from the contact position. Furthermore, as can be seen in Fig. 2, the deflector (17) extends across the width of the sheet of paper. While, Ishii does not explicitly teach a driving device for the feed roller, such a device would inherently be

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found in an ink jet printer, as it is necessary to provide power to the feed roller, so that the recording sheet is fed into the printer.

Ishii teaches the claimed invention with the exception of a plurality of projections on the paper guide surface, wherein at least some of the projections are at least in part disposed inside the printing area, which is located between the contact position and a position where the nose portion opposes the paper guide, the projections being arranged transverse to the printing paper and wherein at least one of the projections extends from within the printing area to a point downstream of the printing area.

Saito et al. teaches (Figs. 27, 31A) an ink jet printer comprising a platen (paper guide) (12) that is positioned opposite a print head (8). The entire surface of the platen has a series of ribs (12a) that are disposed transverse to the printing paper. The ribs allow excess ink to pass through the platen and into an absorbing member (213). This structure prevents ink scattering and contamination of the recording medium (col. 13:56-68 and col. 14:1-6). Furthermore, as can be seen in Fig. 27, the platen extends beyond the printing area. Therefore, since the ribs are formed on the entire surface of the platen, the ribs would extend beyond the printing area.

It would have been obvious to one of ordinary skill in the ink jet art at the time the invention was made to have provided in Ishii et al., a paper guide having an absorbing member and a series of ribs which are formed on the entire surface of the paper guide, so as to extend beyond the printing area, wherein the ribs are formed transverse to the printing paper for the purpose of preventing ink scattering and contamination of the recording medium.

Allowable Subject Matter

Claims 1-23 are allowed.

Claim 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 02/25/04 have been fully considered but they are not persuasive.

The Examiner has carefully considered the Applicant's Declaration and arguments and does not find them to be persuasive.

In the Declaration, the Applicant takes the position that since the recording medium of Ishii does not rest on the platen, then the recording medium could not become contaminated with ink and therefore, there is no motivation to modify Ishii with Saito. This argument is flawed for several reasons.

First, the Applicant's assertion that the recording medium of Ishii does not rest on the platen is not supported by the prior art. The Applicant has not provided any evidence in support of this assertion and thus is merely speculating as to the behavior of the recording medium. A more reasonable explanation of the behavior of Ishii holds that since the presser plate (15) supplies a down-force on the recording medium, then the recording medium would be biased toward the platen by this down-force. Thus, the recording medium would be held against the platen. If the recording medium were free

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to float, then it would be impossible to accurately adjust the printing gap, which is the purpose of Ishii.

Second, even assuming *arguendo* that the recoding medium of Ishii did not contact the platen, Saito still supplies motivation to make the combination. The Applicant is assuming that Saito prevents ink contamination that is caused by the recording medium contacting the platen. Saito is not limited to this narrow interpretation. The ribs of Saito prevent contamination by allowing the ink to pass to an absorbing means that is position beneath the platen (col. 13:56-64). Thus, Saito is not limited to a situation where the recording contacts the platen. The Declaration fails to address this issue and thus fails to negate the motivation for combining Ishii and Saito.

Therefore, the Declaration is insufficient to overcome the *prima facie* case of obvious presented by Ishii and Saito.

In response to applicant's argument that the combination of Ishii and Saito fails to address paper cockling, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael S. Brooke whose telephone number is (571) 272-2142. The examiner can normally be reached on M-F from 5:30 AM-2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael S. Brooke
Primary Examiner
Art Unit 2853

MSB
04/02/04